

REMARKS

In the outstanding Office Action, the Examiner took the following actions:

(a) rejected claims 50, 53-55, 119-130, 135-143, 145-149, 151-158, 160-163, 165-171, 173, and 174, under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 5,040,359 to Thimon ("Thimon") in view of U.S. Patent No. 5,195,296 to Matsumoto ("Matsumoto") and further in view of U.S. Patent No. 4,807,427 to Casteel et al. ("Casteel");

(b) rejected claims 141-143, 145-149, 151-158, 160-163, 165-171, 173, and 174, under 35 U.S.C. § 103(a), as being unpatentable over Thimon in view of Matsumoto, and further in view of Casteel and U.S. Patent No. 5,240,198 to Dörfel (Dörfel); and

(c) objected to claims 144, 150, 159, and 164, as being dependent upon a rejected base claim, but allowable if rewritten in independent form. Applicant acknowledges and appreciates the Examiner's indication of allowable subject matter in claims 144, 150, 159, and 164.

By this reply, no amendments have been made. Claims 50, 53-55, and 119-174, remain pending in this application. Of the pending claims, claims 131-134 and 172 are withdrawn. This reply does not introduce any new matter.

I. Personal Interview

Applicant would like to thank the Examiner for the courtesy extended during the personal interview with inventor Patrick R. Lancaster, III and Applicant's representatives, Elizabeth Burke and Thomas Ho, conducted on June 12, 2008. During the interview, the background of the technology and claims of record were discussed. The Interview Summary states that "applicant discussed the novelty of the invention as of rolling the web itself into a cable to strengthen the stack." While Applicant's representatives and Mr. Lancaster did discuss the rolling of the cable, they did so in the context of (1) arguing that a reference that teaches *rolling a cable of film* as required by claim 119 ("during at least one of the first and second portions of the wrapping cycle,

rolling a portion of the film web into a cable”) has not been applied; (2) noting that Applicant is entitled to be its own lexicographer and that the Examiner is required to apply the definition provided by Applicant in the specification (referring the Examiner to Figs. 2C and 2D and paragraph 44 (describing “conventional” roping) and paragraphs 69-73 which define the term “roll” as it is used in the instant application and its benefits) (see M.P.E.P. § 2111.01, citing Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999)); (3) allowing the Examiner to view a video of a machine practicing a method of wrapping according to claim 119 and discussing the benefits of such operation; and (4) discussing the nonobvious combination recited in claim 119 which requires “driving film from a first elevation to a second elevation lower than the first elevation” *and* “rolling a portion of the film web into a cable.”

Further, during the interview, Applicant’s representatives discussed the claim limitation “driving film from a first elevation to a second elevation lower than the first elevation *through rotation of at least one of an upstream guide roller and a downstream guide roller.*” The Examiner has taken the position that driving film with rollers is well known and, thus, is unpatentable. Assuming *arguendo* that the Examiner is correct, which Applicant does not concede, neither a reference that discloses using rollers to “driv[e] film from a first elevation to a second elevation lower than the first elevation” nor evidence establishing that it is old and well-known has been provided by the PTO. Instead, the Examiner relies on a reference that cannot be modified “to drive film from a first elevation to a second elevation lower than the first elevation” without rendering that reference unsuitable for its intended purpose and changing the principle of operation of

the reference. In view of these defects, Applicant submits that a *prima facie* case of obviousness of the nonobvious combination of “driving film from a first elevation to a second elevation lower than the first elevation” and “rolling a portion of the film web into a cable,” required by claim 119, has not been established. The remarks submitted herewith are consistent with the issues discussed during the interview.

II. Information Disclosure Statement

Two non-patent literature documents were listed on the IDS Form PTO/SB/08 filed on November 28, 2007. Copies of the two documents were also submitted on that date. However, in the copy of the IDS Form PTO/SB/08 attached to the Office Action, the Examiner has not indicated that the two documents were considered by making appropriate notations on the attached form. Applicant respectfully requests that the Examiner provide indication that the two documents were considered with the next communication.

III. Rejection of claims 50, 53-55, 119-130, 135-143, 145-149, 151-158, 160-163, 165-171, 173, and 174, as allegedly unpatentable over Thimon in view of Matsumoto, and further in view of Casteel

Applicant respectfully traverses the rejection of claims 50, 53-55, 119-130, 135-143, 145-149, 151-158, 160-163, 165-171, 173, and 174, as allegedly unpatentable over Thimon in view of Matsumoto, and further in view of Casteel. Neither Thimon, Matsumoto, nor Casteel, whether taken alone or in combination, renders the claims *prima facie* obvious.

Independent claim 119 calls for a combination, including, for example,

driving at least a portion of the film web from a first elevation to a second elevation lower than the first elevation through rotation of at least one of an upstream guide roller and a downstream guide roller . . . during at least

one of the first and second portions of the wrapping cycle, rolling a portion of the film web into a cable.

On page 3 of the Office Action, the Examiner asserts that

Thimon discloses . . . driving at least a portion of the film web from a first elevation to a second elevation lower than the first elevation (Figs. 9 and 13; via rods 37 and 38); note that it is inherent the web has to be driven in order to be feed through the machine, with at least one of an upstream guide roll and a downstream guide roll (Fig. 5; via rollers 62, 63, 37, and 38 or other rollers to drive the web).

Contrary to the Examiner's assertion, Thimon does not teach or suggest the claimed "driving at least a portion of the film web from a first elevation to a second elevation." Rather, Thimon discloses that "the deviating and vertical-offsetting means 27 comprise at least two rods 37, 38 for returning and guiding the band of film 5," and "two return and guide rods 37, 38 . . . having an outer surface capable of permitting the sliding of the band of film with no or only limited friction," (emphasis added). Thimon, column 10, lines 40-45; and column 11, lines 21-25. The fact that the film slides on the outer surfaces of rods 37, 38 indicates that rods 37, 38 do not actively engage film 5. Instead, film 5 passively slides down rods 37, 38. Further, rods 37, 38 do not rotate, and as such, cannot drive film 5 through their rotation. Moreover, since rods 37, 38 do not rotate, rods 37, 38 are not rollers, as would be required for Thimon to render the claim obvious.

In acknowledgment of the deficiencies of Thimon, the Examiner states, on page 3 of the Office Action, "Thimon does not disclose driving the film web through rotation of at least one of the guide roller." In an attempt to remedy the deficiencies of Thimon, the Examiner cites Matsumoto, and asserts that

Matsumoto discloses a similar method of wrapping a load with a film web with the use of driven rollers (via rollers 3 and 3' driven by driving unit 8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted Thimon's rods (37 and 38) by the use of driven rollers, as suggested by Matsumoto, in order to stretch the film before wrapping a load and thereby tightening the load in both the vertical and horizontal directions with the film (column 1, lines 43-45).

Applicant respectfully disagrees with the Examiner's assertion. Matsumoto discloses an apparatus including the following:

a turntable 1 on which a load (a) to be wrapped is placed. A support post 2 carrying a roll of stretchable plastic film (b) is spaced by a predetermined distance from the turntable 1. A pair of opposed stretching rollers 3, 3' with vertical shafts are disposed between the turntable 1 and the support post 2 As shown in FIG. 2, ridges 6 and grooves 7 are alternately formed on the outer peripheral surface of each of the stretching rollers 3, 3' so that the ridges 6 on one of the stretching rollers 3, 3' mesh with the grooves 7 on the other stretching roller the film (b) passing between the stretching rollers 3, 3' is forcibly stretched both laterally and longitudinally of the film (b) by the actions of the intermeshed ridges 6 and grooves 7. Matsumoto, column 2, lines 20-26, 30-34, and 38-41.

The Examiner's proposed modification of replacing rods 37 and 38 of Thimon with rollers 3 and 3' of Matsumoto would not have been obvious since the proposed modification would render Thimon unsatisfactory for its intended purpose. Thimon requires that rods 37 and 38 be tiltable to guide film 5 to a vertically lower position. See Thimon, column 10, lines 40-62. If rods 37 and 38 of Thimon were replaced with rollers 3 and 3' of Matsumoto, tilting could not take place, since the close interfitting engagement between ridges 6 and grooves 7 of rollers 3 and 3' would prevent tilting movement. Thus, Thimon would be rendered unsatisfactory for its intended purpose of creating a banding of excellent quality on the lower edge of load 2. See Id. at column 3, lines 42-47.

Furthermore, Thimon discloses that rollers 59, 60 or 62, 63 can operate as a differential-speed two-roller pre-stretching device. See Id. at column 13, lines 1-15.

The Examiner's proposed modification, by incorporating rollers 3 and 3' of Matsumoto for stretching film, would add a second round of stretching to film 5 in Thimon above and beyond the desired stretching already imparted by rollers 59, 60 or 62, 63. This excessive stretching would change the principle of operation of Thimon. In addition, the principle of operation of Thimon is to use rods, not rollers, to slidably guide film 5 with little or no frictional engagement, as evidenced by the lengths to which Thimon goes to in order to prevent frictional engagement between rods 37 and 38 and film 5 (e.g., forcing compressed air through holes 47 in surfaces of rods 37 and 38). See Id. at column 11, lines 22-36. Rollers 3 and 3' of Matsumoto, on the other hand, are designed to frictionally engage and stretch film "b". Thus, replacing rods 37 and 38 with rollers 3 and 3' would change the principle of operation of Thimon for this additional reason. Since the Examiner's proposed modification of Thimon with Matsumoto would not only render Thimon unsatisfactory for its intended purpose, but would also change the principle of operation of Thimon, there is no suggestion or motivation to make the proposed modification. See M.P.E.P. § 2143.01.

Casteel fails to remedy the above-described deficiencies of Thimon and Matsumoto. Further, the Examiner does not rely on Casteel for such a purpose. See Office Action, page 4. Therefore, for at least these reasons, the combination of Thimon, Matsumoto, and Casteel, fails to establish a *prima facie* case of obviousness.

Notwithstanding the above discussion, which is sufficient for the withdrawal of the rejection, the rejection based on Thimon, Matsumoto, and Casteel, is improper for additional reasons. Casteel teaches a stretch wrapping machine including spools 33 that "come together in adjacent overlapping spacing with the film web W being reduced

therebetween to the film rope R required.” Casteel, column 3, lines 15-19. If the teachings of Casteel were applied to Thimon, film 5 of Thimon would be gathered and reduced into the shape of film rope R of Casteel, rendering Thimon unsuitable for its intended purpose of pleating or curling only lower edge 30 of film 5 to obtain a better package, since the width of film rope R is significantly narrower than the width of film required by Thimon. See Thimon, column 12, lines 44-64; and FIG. 4. The Examiner’s proposed modification would also change the principle of operation of Thimon, since Thimon would lose the ability to deviate or offset film 5 in a downward direction, since spools 33 of Casteel would force the entire width of film 5 upward into the form of film rope R. Thus, since the proposed modification of Thimon with Casteel would render Thimon unsatisfactory for its intended purpose, and would change the principle of operation of Thimon, there would be no suggestion or motivation to make such a modification, and the combination would not have been obvious. See M.P.E.P. § 2143.01.

Accordingly, for at least the above reasons, Thimon, Matsumoto, and Casteel, whether taken alone or in combination, do not meet the requirements for proving a *prima facie* case of obviousness. Thus, withdrawal of the rejection of independent claim 119 is requested, along with the timely allowance thereof.

Claims 50, 53-55, 120-128, 139, 141, and 153-155 depend either directly or indirectly from independent claim 119, and therefore are allowable for at least the same reasons that independent claim 119 is allowable. In addition, at least some of these claims recite unique combinations that are neither taught nor suggested by the cited art, and are therefore also separately patentable.

Applicant respectfully traverses the rejection of claims 129, 130, 135-138, 140, 156, 167-169, 171, 173, and 174, as allegedly unpatentable over Thimon in view of Matsumoto, and further in view of Casteel. Neither Thimon, Matsumoto, nor Casteel, whether taken alone or in combination, renders the claims *prima facie* obvious.

Independent claim 129, while of different scope from independent claim 119, recites similar features. For example, independent claim 129 calls for a combination, including, for example,

driving at least a portion of the film web from a first elevation to a second elevation lower than the first elevation, through rotation of at least one of an upstream guide roller and a downstream guide roller . . . and during at least one of the first and second portions of the wrapping cycle, gathering a portion of the film web.

Thus, Thimon, Matsumoto, and Casteel, whether taken alone or in combination, do not meet the requirements for proving a *prima facie* case of obviousness, for at least reasons similar to those discussed above with respect to independent claim 119. Reconsideration of the rejection, and the timely allowance of independent claim 129, are respectfully requested.

Claims 130, 135-138, 140, 156, 167-169, 171, 173, and 174 depend either directly or indirectly from independent claim 129, and therefore are allowable for at least the same reasons that independent claim 129 is allowable. In addition, at least some of these claims recite unique combinations that are neither taught nor suggested by the cited art, and are therefore also separately patentable.

IV. Rejection of claims 141-143, 145-149, 151-158, 160-163, 165-171, 173, and 174, as allegedly unpatentable over Thimon in view of Matsumoto, and further in view of Casteel and Dörfel

Applicant respectfully traverses the rejection of claims 141-143, 145-149, 151-158, 160-163, 165-171, 173, and 174 as being unpatentable over Thimon in view of Casteel, and further in view of Matsumoto and Dörfel. Dörfel fails to remedy the deficiencies of Thimon, Matsumoto, and Casteel, described above with respect to independent claims 119 and 129. Further, Dörfel is not cited for such a purpose. See Office Action, pages 6 and 7. Thus, since claims 141-143, 145-149, 151-158, 160-163, 165-171, 173, and 174 depend either directly or indirectly from one of independent claims 119 and 129, claims 141-143, 145-149, 151-158, 160-163, 165-171, 173, and 174 are allowable at least for the same reasons that independent claims 119 and 129 are allowable. According, Applicant requests withdrawal of the rejection, and the timely allowance of these claims.

V. Objection to claims 144, 150, 159, and 164

Claims 144, 150, 159, and 164 depend either directly or indirectly from one of independent claims 119 and 129, and therefore are allowable for at least the same reasons that independent claims 119 and 129 are allowable. In addition, at least some of these claims recite unique combinations that are neither taught nor suggested by the cited art, and are therefore also separately patentable.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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